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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,508	12/10/2001	Miguel N. Bermudez	042390P11384D	1145

7590

11/05/2003

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 11/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,508

Applicant(s)

BERMUDEZ, MIGUEL N.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,8,19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 2, 6, 9 and 20 have been canceled. Claims 1, 3, 4, 19, 21 and 22 have been amended for further examination.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 3-5, and 19, 21-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash et al (5,704,650) in view of Kelly, Jr and further in view of Blankenship et al (6,536,660).

Laurash et al discloses in Fig. 1, 4 and 5, an article comprising: first label (26) and second label (29), wherein each label has a printed indicied identifier (56, as stated in Col. 7, lines 10-15); and wherein the first and second label are removably fixed from an object's surface (Col. 7, lines 57-63, which can be a container) and attached to any other desirable surface (Col. 8, lines 1-5, which can be a device).

However, Laurash et al does not disclose: an object being a component container; an identifier that identifies a component inside the component container; and wherein the identifier indicia is electronically stored in the component and read therefrom for printing labels.

Kelly, Jr. discloses an object being a component container (24) having components (20) and a device (contents inside component box (20)), wherein a label (30) is removably affixed to

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the component container, and has an identifier (bar code 42) that identifies the component inside the container.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's label to include a label having an identifier which identifies the components inside of a container, as taught by Kelly, Jr. for the purpose of keeping an inventory record.

However, Laurash et al and Kelly, Jr. do not disclose: wherein the identifier is electronically stored in the component and read therefrom for printing labels.

Blankenship et al discloses in Fig. 1-5, an identifier which can be electronically stored on a component (in this case encoding by imprinting magnetic impulses on a wire), read, and placed as a bar code on an adhesive label (Col. 3, lines 3-33), and wherein the adhesive label is placed on any desirable surface such as a container (reel or barrel for holding wire).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's and Kelly's article to include an identifier which can be electronically stored as well as encoded (bar code) on a label as taught by Blankenship et al for the purpose of providing the end user with tracking information which holds detailed non-deletable information pertaining to the component.

In regards to **Claims 1 and 19**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable

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of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the identifier in Laurash et al's article can be used for printing labels.

In regards to **Claims 3, 4, 21 and 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the first and second label at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

3. Claims 7, 8, 25 and 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over in Laurash et al as modified by Kelly, Jr and Blankenship et al, and further in view of Brower et al (6,348,685).

Laurash et al as modified by Kelly and Blankenship et al discloses an article comprising all the elements as disclosed in Claims 1 and 19, and as set forth above.

However, Laurash et al, Kelly and Blankenship et al do not disclose: wherein the container object is constructed of polyester and is a electrostatic discharge bag.

Brower et al discloses in Fig. 9, an polymeric material (polyester) electrostatic discharge bag (14) container object.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's object with an electrostatic bag object as taught by Brower et al for the purpose of holding electronic equipment.

Response to Arguments

4. Applicant's arguments filed on August 18, 2003, have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, The Laurash et al reference is used to disclose labels that has identifier indicia and wherein the label can be removable attached to a desired object's surface and placed on another desired object. However, the Laurash et al reference does not disclose wherein the labels are placed on a container and device. The Kelly, Jr. discloses wherein the labels are placed on a component container having components inside, which are also identifiable by the identifier label

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placed on each component package surface. Therefore, it would have been obvious to modify Laurash et al's article to include a label as taught by Kelly, Jr. that is placed on one container object's surface and also placed on another component object's surface. However, Laurash et al does not disclose wherein the identifier (indicia information) is also stored and placed electronically on a component object. Blankenship is recited for disclosing an identifier (indicia information) which can be electronically stored and placed on an object as well as being printed on a label. Therefore, it would have been obvious to modify Laurash et al's article with an identifier (indicia information) as taught by Blankenship et al, which can be placed on a label as well as be electronically stored on a component.

Therefore, the rejection of these claims have been maintained.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

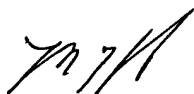
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 2, 2003



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